

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

ROKU INC.,)
)
)
Plaintiff,) Civil Action No. 1:22-cv-00850-LJL
v.)
)
THE INDIVIDUALS, CORPORATIONS,)
LIMITED LIABILITY COMPANIES,)
PARTNERSHIPS, AND)
UNINCORPORATED ASSOCATIONS)
IDENTIFIED ON SCHEDULE A)
HERETO,)
)
Defendants.)
)

DEFENDANT MONSTERKING'S RESPONSE TO THE ORDER TO SHOW CAUSE

Defendant Monsterking (“Defendant”) submits this Opposition to Plaintiff’s Motion for Preliminary Injunction.

Defendant is an internet seller of replacement remote controls for TVs, including Roku TV. Plaintiff accuses Defendant of selling the remote controls of the brand “Gxedizx,” who upon information and belief, is not a party to this case.

A copy of Plaintiff’s evidence of sales by Defendant is included as Exhibit A.

The Preliminary Injunction should be denied because Plaintiffs cannot prove that there is a likelihood of success on the merits.

In order for a movant to prevail on its motion for a preliminary injunction, it must demonstrate both “(a) irreparable harm and (b) either a likelihood of success on the merits or sufficiently serious questions going to the merits to make them a fair ground for litigation and a

balance of hardships tipping decidedly in the movant's favor." *United States Shoe Corp. v. Brown Grp., Inc.*, 740 F. Supp. 196, 197 (S.D.N.Y. 1990)

To prove trademark infringement, the owner must demonstrate that the alleged infringer's use of the mark is likely to cause confusion or mistake as to the origin of the two products. See, *Radiance Found, Inc. v. NAACP*, 786 F.3d 316, 322 (4th Cir. 2015). Likewise, when a mark is referred to in descriptive terms, the alleged infringer may defend his use of the terms by demonstrating that he used them in good faith in the descriptive sense and not as a trademark, thus making "fair use" of descriptive terms, as codified in Section 33(b)(4) of the Lanham Act. *Brown Grp.*, 740 F. Supp. at 198. A defendant that is not using the phrase as an identifier or trademark to indicate origin or source is not infringing the mark. Id. at 199.

1. Defendant's Use of the Word "ROKU" in Advertising Constitutes Descriptive Fair Use

Defendant has several products that Plaintiff alleges violates its trademark. These are listed below:

Gxcdizx Universal Replacement for TCL Roku TV Remote, RC280 RC282 Remote for TCL Roku Smart LED TV 55s405 (Ex. A, at 2);

Gxcdizx Universal Remote Control for Roku 1/2/3/4 HD LT XS XD IR ROKU Remote (Id., at 6);

Gxcdizx Universal Remote Control for TCL/Insignia/HISENSE/Sharp/HAIER/LG/RCA/ Element/ SANY O/ HITACHI/ Philips/ ONN/ Westinghouse Roku TV and Roku Streaming Player Boxes (Id., at 11);

Gxcdizx RC280 Universal Remote for TCL-Roku-TV-Remote, for All TCL Roku Smart 4K HD LED TV, with Shortcut Buttons (Id., 17); and

Gxcdizx Newest Technology Replacement Remote for ROKU 1/2/3/4 Express+Premiere+/ Ultra (Id., at 23)

For each of these listings, Defendant identifies that the remote controls are compatible with Roku technology. Without using the word “Roku,” consumers have no clue whether the replacement remote will work with Roku TV. Just like phone charger sellers that state charger compatible with Apple or Samsung, there is no way to get around the usage of trademarked words to describe the compatibility of certain after-market products. Moreover, Defendant is not using the word as a trademark or identifier to indicate origin or source of the product. Instead, it is used in a sentence to indicate the compatibility of the product.

Moreover, the designation that these are Gxcdizz products informs the customer of the manufacturer and that they were not produced by Roku or a Roku affiliate.

2. Defendants' Product Do Not Infringe Plaintiff's Purple Design Mark

Plaintiff accuses Defendant of infringing US TM Reg. No. 6076830, which is a design mark directed to a particular color of purple. A copy of the protected color of purple alongside Defendant's products is shown in the table below.

US TM Reg. No. 6076830	Product from Ex. A, at 2, 17	Product from Ex. A, at 6, 11	Product from Ex. A, at 23
			

As shown above, the color employed by Defendants' products is a much darker shade than the bright-purple that Plaintiff registered as a trademark. Upon information and belief, Plaintiff registered "Blue-Violet", whereas Defendants' products utilize indigo. This is a substantial and clear color difference. Given the very clear differences in color shade, customers are not likely to be confused as to the origin of the product.

3. Defendants Usage of the Roku Word Mark Would Not Lead to Customer Confusion

The term "USARMT ROKU-T11078" is found in small letters on the bottom of Defendants' products "Gxcdizx Universal Remote Control for Roku 1/2/3/4 HD LT XS XD IR ROKU Remote" and "Gxcdizx Universal Remote Control for TCL/Insignia/HISENSE/Sharp/HAIER/LG/RCA/Element/ SANY O/ HITACHI/ Philips/ ONN/ Westinghouse Roku TV and Roku Streaming Player Boxes" (Ex. A, at 6, 11).

The relevant confusion is that which "affects 'the purchasing and selling of the goods or services in question.'" *Lang v. Retirement Living Publ'g Co.*, 949 F.2d 576, 583 (2d. Cir. 1991) (quoting *Programmed Tax Systems, Inc. v. Raytheon Co.*, 439 F. Supp. 1128, 1132 (S.D.N.Y. 1977)). Accordingly, the overall impression of the advertisement is of central importance.

The advertisements for these items are shown below.

Gxcdizx Universal Remote Control for Roku 1/2/3/4 HD LT XS XD IR ROKU Remote

Brand: Gxcdizx

Price: \$12.99

Get \$75 off instantly: Pay \$0.00 \$12.99 upon approval for the Amazon Rewards Visa Card. No annual fee.

Brand	Gxcdizx
Compatible Devices	Television
Connectivity Technology	Infrared
Battery Description	AAA

About this item

- 【Fitment】 - Universal Roku Remote Control Fit for TCL/ Insignia/ HISENSE/ Sharp/ HAIER/ LG/ RCA/ Element/ SANYO/ HITACHI/ Philips/ ONN/ Westinghouse Roku TV and Roku Streaming Player Boxes, including NETFLIX, Hulu, Rdio, Vudu, Spotify, You Bute, SHOWTIME, MGO, HBONOW, CBSNEWS, Google Play, CINEPLEX, Amazon and Sling channel shortcut keys.
- 【Compatibility】 This replacement remote control works for Roku 1/2/3/4 HD LT XS XD;Roku express/+, Roku premiere/+, Roku Ultra . NOT COMPATIBLE WITH ROKU STREAMING STICK PLAYERS.
- 【Best Service】 - Please contact us if you received the part damaged or if the part you ordered did not fix your problem.We would like to ensure 100% customer satisfaction for you.
- 【Easy to Use】 - NO programming, no pairing, just insert the 2 x AAA batteries 【not included】 to get it work.
- 【Package Included】 - 1 x Universal Replacement Remote Control



Gxcdizx Universal Remote Control for TCL/Insignia/HISENSE/Sharp/HAIER/LG/RCA/Element/SANYO/HITACHI/Philips/ONN/Westinghouse Roku TV and Roku Streaming Player Boxes

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Price: \$12.99

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- 【Package Included】 - 1 x Universal Replacement Remote Control



Roll over image to zoom in

For both, the brand is specifically identified as “Gxcdizx” and not Roku. Likewise, the descriptive title of the product calls it a “Gxcdizx Universal Remote Control Replacement for” other products, including Roku. A reasonable person reading the title would understand that the brand is Gxcdizx is this product merely compatible with Roku products, and not made by Roku.

CONCLUSION

For the reasons above, Defendant respectfully requests that this Court release the preliminary injunction as to Defendant.

Respectfully submitted,

Brooklyn, New York

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